

**REMARKS**

The Office action dated March 6, 2003 and the cited references have been carefully considered.

**Status of the Claims**

Claims 3-6, 30, and 32 are pending. Claims 3, 4, and 30 are canceled. Claims 33 and 34 are new, reciting subject matter already disclosed in the original specification, original claims, or original figures. Therefore, claims 5, 6, and 32-34 remain in the current prosecution.

Claims 5, 6, and 32 are rejected under 35 U.S.C. § 112, first paragraph.

Claims 5 and 32 are rejected under 35 U.S.C. § 112, second paragraph.

Claims 3-6, 30, and 32 are rejected under 35 U.S.C. § 102(b) as being anticipated by Webb et al. (U.S. Patent 3,011,870; hereinafter "Webb").

Claims 3, 4, 5, 30, and 32 are rejected under 35 U.S.C. § 102(b) as being anticipated by Yamamoto et al. (U.S. Patent 5,820,843; hereinafter "Yamamoto").

Claims 3, 4, 5, 6, 30, and 32 are rejected under 35 U.S.C. § 102(b) as being anticipated by Yukinobu et al. (U.S. Patent 5,132,104; hereinafter "Yukinobu").

Claims 3-6, 30, and 32 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Webb.

Claims 3, 4, 5, 30, and 32 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Yamamoto.

Claims 3-6, 30, and 32 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Yukinobu.

Claims 3, 4, and 30 have been canceled. Therefore, the rejections of these claims are now moot. The Applicants respectfully traverse all of these rejections with respect to the remaining claims for the reasons set forth below.

**Claim Rejection Under 35 U.S.C. § 112, First Paragraph**

Claims 5, 6, and 32 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. The Applicants respectfully traverse this rejection because the photographs filed with the original application show the scales (in the upper left-hand corner of each photograph) for acicular bodies in the photographs. The same original photographs were also included with Applicants' response to paper No. 6 to support Applicants' argument. From the length scale shown in each original photograph, a person skilled in the art can determine the cross-sectional dimension of the acicular bodies in the photograph. The use of a dimensional scale shown in a photograph to determine the dimensions of objects shown in the same photograph is universally accepted. "An applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as . . . figures . . . that fully set forth the claimed invention." M.P.E.P. § 2163, p. 2100-155 (8<sup>th</sup> ed., Aug. 2001) (quoting *Lockwood v. American Airlines, Inc.*, 41 U.S.P.Q.2d 1961, 1966 (Fed. Cir. 1997)). Therefore, the recited dimension is not new matter because it is inherent from the scale shown in the original photograph.

In any event, claims 5, 6, and 32 have been amended without narrowing the scope of each claim, and now overcome this rejection.

**Claim Rejection Under 35 U.S.C. § 112, Second Paragraph**

Claims 5 and 32 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Claims 5 and 32 have been amended to include "of the Periodic Table of the Elements" after each recitation of the Groups of the Periodic Table. Therefore, this rejection is now overcome.

**Claim Rejection Under 35 U.S.C. § 102(b)**

Claims 3-6, 30, and 32 are rejected under 35 U.S.C. § 102(b) as being anticipated by Webb. Claims 3, 4, and 30 have been canceled. Therefore, the rejection with respect to claims 3, 4, and 30 is now moot. The Applicants respectfully traverse the rejection with respect to claims 5, 6, and 32 because Webb does not disclose each and every element of each of claims 5, 6, and 32.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a *single* prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). "The identical invention must be shown in as complete detail as is contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

Webb discloses only needles of aluminum oxide, more particularly  $\alpha$ -alumina. Webb does not disclose acicular bodies of Groups IIIA, IVA, VA, VB, VIB, VIIA of the Periodic Table of the Elements, and rare earth metals, as recited in claims 5, 6, and 32. Since Webb does not disclose every element of each of claims 5, 6, and 32, Webb does not anticipate these claims.

Claims 3, 4, 5, 30, and 32 are rejected under 35 U.S.C. § 102(b) as being anticipated by Yamamoto. Claims 3, 4, and 30 have been canceled. Therefore, the rejection with respect to claims 3, 4, and 30 is now moot. The Applicants respectfully traverse the rejection with respect to claims 5 and 32.

Yamamoto discloses only needle-like zinc (belonging to Group IIB) oxide or an aluminum (belonging to Group IIIB) compound. Yamamoto does not disclose acicular bodies of Groups IIIA, IVA, VA, VB, VIB, VIIA of the Periodic Table of the Elements, and rare earth metals, as recited in claims 5 and 32. Since Yamamoto does not disclose every element of each of claims 5 and 32, Yamamoto does not anticipate these claims.

Claims 3-6, 30, and 32 are rejected under 35 U.S.C. § 102(b) as being anticipated by Yukinobu. Claims 3, 4, and 30 have been canceled. Therefore, the rejection with

respect to claims 3, 4, and 30 is now moot. The Applicants respectfully traverse the rejection with respect to claims 5, 6, and 32.

Yukinobu discloses only indium tin (belonging to Groups IIIB and IVB) oxide. Yukinobu does not disclose acicular bodies of Groups IIIA, IVA, VA, VB, VIB, VIIA of the Periodic Table of the Elements, and rare earth metals, as recited in claims 5, 6, and 32. Since Yukinobu does not disclose every element of each of claims 5, 6, and 32, Yukinobu does not anticipate these claims.

**Claims Rejection Under 35 U.S.C. § 103(a)**

Claims 3-6, 30, and 32 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Webb. Claims 3, 4, and 30 have been canceled. Therefore, the rejection with respect to claims 3, 4, and 30 is now moot. The Applicants respectfully traverse the rejection with respect to claims 5, 6, and 32 because Webb does not teach or suggest all of the limitations of each of these claims.

"To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." M.P.E.P. § 2143.03, p. 2100-126 (8<sup>th</sup> ed., Aug. 2001).

Webb teaches only needles of aluminum oxide, more particularly  $\alpha$ -alumina. Webb does not teach or suggest acicular bodies of Groups IIIA, IVA, VA, VB, VIB, VIIA of the Periodic Table of the Elements, and rare earth metals, as recited in claims 5, 6, and 32. Since Webb does not teach or suggest all the claim limitations of each of claims 5, 6, and 32, Webb does not render these claims obvious.

Claims 3, 4, 5, 30, and 32 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Yamamoto. Claims 3, 4, and 30 have been canceled. Therefore, the rejection with respect to claims 3, 4, and 30 is now moot. The Applicants respectfully traverse the rejection with respect to claims 5, 6, and 32 because Yamamoto does not teach or suggest all of the limitations of each of these claims.

Yamamoto teaches only needle-like zinc (belonging to Group IIB) oxide or an aluminum (belonging to Group IIIB) compound. Yamamoto does not teach or suggest

acicular bodies of Groups IIIA, IVA, VA, VB, VIB, VIIA of the Periodic Table of the Elements, and rare earth metals, as recited in claims 5 and 32. Since Yamamoto does not teach or suggest all of the limitations of each of claims 5 and 32, Yamamoto does not render these claims obvious.

Claims 3-6, 30, and 32 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Yukinobu. Claims 3, 4, and 30 have been canceled. Therefore, the rejection with respect to claims 3, 4, and 30 is now moot. The Applicants respectfully traverse the rejection with respect to claims 5, 6, and 32 because Yukinobu does not teach or suggest all of the limitations of each of these claims.

Yukinobu teaches only indium tin (belonging to Groups IIIB and IVB) oxide. Yukinobu does not disclose acicular bodies of Groups IIIA, IVA, VA, VB, VIB, VIIA of the Periodic Table of the Elements, and rare earth metals, as recited in claims 5, 6, and 32. Since Yukinobu does not teach or suggest all of the limitations of each of claims 5, 6, and 32, Yukinobu does not render these claims obvious.

In view of the above, it is submitted that the claims are patentable and in condition for allowance. Reconsideration of the rejection is requested. Allowance of claims at an early date is solicited.

Respectfully submitted,

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